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In re Patent Application of :

Jerome AUCOUTURIER *et al.*

Group Art Unit: 1644

Serial No.: 09/698,121

Examiner: G. R. Ewoldt, Ph.D.

Filed: October 30, 2000

For: NOVEL VACCINE COMPOSITION AND USE OF SURFACTANTS
AS ADJUVANTS OF IMMUNITY

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed August 2, 2001, applicants hereby traverse the restriction requirement and request reconsideration and withdrawal of said restriction requirement. The shortened statutory period for response was set to expire on September 2, 2001. Accordingly, a Petition for Extension of Time along with the appropriate fee for a one month extension is filed herewith to extend the period of reply to October 2, 2001.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required applicants under 35 U.S.C. § 121 to elect one of the following groups of claims:

I. Claims 1-15, 17-18, 21-27, and 29 drawn to a composition comprising an antigen and an adjuvant, or surfactant, or combination of surfactants, classified in Class 424, subclass 185.1+.

II. Claims 1-15, 17-18, 21-27, and 29 drawn to a composition comprising an *in vivo* generator of a compound comprising an amino acid sequence, and an adjuvant, or surfactant, or

combination of surfactants, classified in Class 424, subclass 185.1+ and Class 435, subclasses 91.1+ and 320.1.

III. Claims 1, 16, and 28 drawn to a composition comprising an antigen and an adjuvant, or surfactant, or combination of surfactants, and a sympathomimetic, classified in Class 424, subclass 185.1+.

IV. Claims 1, 16, and 28 drawn to a composition comprising an *in vivo* generator of a compound comprising an amino acid sequence, and an adjuvant, or surfactant, or combination of surfactants, and a sympathomimetic, classified in Class 424, subclass 185.1+ and Class 435, subclasses 91.1+ and 320.1.

V. Claims 19-20 and 30-32 drawn to a method of providing an adjuvant effect comprising a composition comprising an antigen and an adjuvant, or surfactant, or combination of surfactants, classified in Class 424, subclass 185.1+.

VI. Claims 19-20 and 30-32 drawn to a method of providing an adjuvant effect comprising a composition comprising an *in vivo* adjuvant, or surfactant, or combination of surfactants, classified in Class 424, subclass 185.1+.

ELECTION

In the event that the restriction requirement is not withdrawn, applicants hereby provisionally elect the claims of Invention Group V (Claims 19-20 and 30-32) and provisionally elect composition H (Mannitan oleate (8 EOs)) as the adjuvant, with traverse. Species comprising composition H as the adjuvant read on each claim of Invention Group V (Claims 19, 20 and 30-32).

TRAVERSAL

There are two elements for a proper requirement for restriction between patentably distinct inventions:

(1) The invention must be independent (see MPEP § 802.01, § 806.04, and § 808.01) or distinct as claimed (see MPEP § 806.05-§ 806.05(i)); and

(2) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and § 808.02).

Applicants respectfully traverse the Examiner's restriction requirement for failing to satisfy these elements, as follows.

As noted above, a requirement for restriction is only proper when a serious burden is placed on the Examiner. Applicants respectfully submit that a search and examination of all claims may be made without imposing a serious burden on the Examiner, as evidenced by the classification of Invention Groups I, II, III, IV and V. In fact, as the Examiner correctly notes in the Office Action, all of the invention groups are classified in the same class and subclasses (i.e., Class 424, subclass 185.1+) notwithstanding the classification of Invention Groups II and IV, which are additionally classified in Class 435, subclasses 91.1+ and 320.1.

Further, with regard to both the restriction requirement and the election of species, the search would be coextensive, contrary to the Examiner's assertion in the Office Action. Therefore, the election of species requirement is improper.

In view of the foregoing, an important advantage in pursuing just one application encompassing all of the invention groups cited by the Examiner is that the examination work of the U.S. Patent and Trademark Office would be simplified, insofar as duplication of searching effort would be eliminated.

Further, applicants respectfully submit that the claims of the designated groups have not acquired a separate status in the art for examination purposes. In particular, the Examiner has

failed to establish separate status in the art by citing patents which are evidence of such separate status, or showing separate fields of search. See MPEP § 808.02(B).

Accordingly, the restriction requirement will serve no purpose other than to unfairly and improperly require applicants to pay duplicative PTO fees to obtain patent protection for their invention.

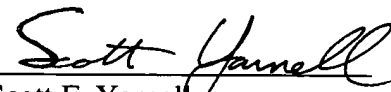
Applicant submits herewith a check in the amount of \$110.00 for a one month extension of time and believes that no further fees are necessary in connection with the filing of this document. In the event any additional fees are necessary, please charge or credit any such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206.

In view of the above remarks, it is thus respectfully requested that the restriction requirement be withdrawn and that all claims be allowed to be prosecuted in the same application.

Respectfully submitted,

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